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10/829,644	04/22/2004	Travis J. Parry	200312834-1	6984
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EXAMINER LANIER, BENJAMINE				
ART UNIT 2432		PAPER NUMBER		
NOTIFICATION DATE 05/17/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/829,644

Applicant(s)

PARRY ET AL.

Examiner

BENJAMIN E. LANIER

Art Unit

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 37-51 and 54-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-25, 27, 28, 30-34, 37-51, 54, 55 and 58-60 is/are rejected.
- 7) ☒ Claim(s) 12, 26, 29, 56 and 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Proficiency's Patent Drawing Review (PTO-544)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 20 April 2010 amends claim 29. Claims 58-60 has been added. Applicant's amendment has been fully considered and entered.

Response to Arguments

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant argues, "Paragraph [0015] which describes an embodiment wherein an authorization interface 16 is formed along one or more side edges of a stack of print medium. Once the stack of print medium is removed from a printer, the authorization interface 16 remains with the print medium." This argument has been fully considered and is persuasive. The rejection of claims 12, 26, and 29 under 35 USC 112 has been withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 46-51 are rejected under 35 U.S.C. 102(a) and/or 102(e) as being anticipated by Asakura, U.S. Patent No. 6,711,362. Referring to claims 46-48, 50, 51, Asakura discloses a printing system wherein consumable cartridges include user id information and a count value

that are read from the cartridge by the printer to control access to the cartridge (Col. 3, line 22 - Col. 4, line 7, 30-50), which meets the limitation coupling authorization data identifying authorized users of the resource to the resource, coupling the resource to the image-forming device, sensing the authorization data, and limiting use of the resource by the device based upon the sensed authorization data, limiting use of the resource includes preventing any use of the resource by an individual not included in the authorization data, coupling authorization data to the resource includes recording authorization data upon a memory coupled to the consumable resource, coupling authorization data includes coupling an optically readable code for providing the authorization data to the consumable resource.

Referring to claim 49, Asakura discloses that if the user ids do not match a message is displayed to the user (Col. 4, lines 43-47), which meets the limitation of notifying unauthorized individuals that they are not authorized to use the resource.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1-11, 13-15, 18-25, 27, 28, 30, 33, 45-51, 54, 55, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanaoka, U.S. Publication No. 2006/0045595, in view of Asakura, U.S. Patent No. 6,711,362. Referring to claims 1, 10, 11, 14, 15, 18-20, 22, 23, 27, 28, 30, 33, 45-48, 50, 51, 54, 55, Hanaoka discloses printer rental system that includes a printer (Figure 1, 100), which meets the limitation of an image-forming device. The printer utilizes cartridges delivered by the rental service (Figure 1), which meets the limitation of a first consumable resource configured to be consumed by the device in forming a printed image. The printer authenticates use of the cartridge by comparing a manually entered use permit ID ([0080]) with a previously stored use permit ID ([0073]), which meets the limitation of a user interface configured to receive authorization input from a prospective user, the device includes an authorization receiving interface having at least one electronically conductive contact, the user interface is configured to receive authorization input from a prospective user comprising a person, a cartridge containing the consumable resource. The printer authenticates use of the printer by authenticating the user and the cartridge ([0070]), which meets the limitation of a processor in communication with the user interface, wherein the processor is configured to determine if a prospective user is authorized to use the resource based upon the authorization input and interaction with the granting interface, the processor is fixedly coupled to the device/resource, limiting use of the resource by the device based upon the sensed authorization data, limiting use of the resource includes preventing any use of the resource by an individual not included in the authorization data. Hanaoka does not disclose that the cartridge stores authorized user id information. Asakura discloses a printing system wherein consumable cartridges include

user id information and a count value (Col. 3, line 30 - Col. 4, line 7), which meets the limitation of an authorization granting interface coupled to the resource and configured based upon authorized users of the resource, the authorization granting interface is configured to remain coupled to unused portions of the consumable resource upon withdrawal of the unused portions of the consumable resource from the image forming device, the authorization granting interface includes a digital memory coupled to the cartridge, the authorization granting interface comprises at least electronically conductive contact, a programmable medium coupled to the cartridge and providing the authorization data, the authorization granting interface is configured to grant and deny use of the resource, the authorization granting interface is coupled to the cartridge, coupling authorization data identifying authorized users of the resource to the resource, sensing the authorization data, coupling an optically readable code for providing the authorization data to the consumable resource, the authorization granting interface identifies a person who is authorized to use the resource, coupling authorization data to the resource includes recording the authorization data upon a memory coupled to the consumable resource, the authorization granting interface is configured to grant and deny use of the resource, the processor is configured to prevent the prospective user from using the first consumable resource in the image forming device based on input of a first authorization input and interaction with the granting device by the first prospective user, wherein the processor is configured to allow the prospective user to use a second consumable resource in the image forming device based upon input of the first authorization input and interaction with the granting device by the first prospective user. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the consumable cartridges of Hanaoka to store the user id information

along with a count value in order to prevent use of pirated cartridges while also preventing unauthorized refilling of genuine cartridges as taught by Asakura (Col. 1, lines 17-33 & Col. 4, lines 15-21).

Referring to claims 2, 13, Hanaoka discloses that the user utilizes a computer containing a display which is capable of displaying notification messages (Figure 1, 10), which meets the limitation of the user interface is configured to indicate to the prospective user whether the prospective user is authorized in response to control signals generated by the processor, the user interface includes a mouse, a keyboard.

Referring to claims 3, 4, Hanaoka discloses that the printer authenticates use of the printer by authenticating the user and the cartridge ([0070]), which meets the limitation of the processor is configured to prevent use of the resource by the prospective user when the prospective user is not authorized and to permit use of the resource when the prospective user is authorized.

Referring to claim 5, Hanaoka discloses that the use permit ID is stored in the printer ([0073]), which meets the limitation of a memory configured to receive and store authorization input.

Referring to claims 6-9, 24, 25, Hanaoka discloses that the cartridge can be an ink or toner cartridge ([0084]), which meets the limitation of the resource includes a printing material configured to be deposited upon a medium, the printing material comprises an ink, the printing material comprises a toner, the resource is contained within a cartridge.

Referring to claim 21, Hanaoka discloses that the use permit ID is received from a server ([0072]), which meets the limitation of the user interface is configured to receive authorization input from a prospective user comprising a device.

Referring to claim 49, Hanaoka discloses that an error message is received when the user is not authenticated ([0073]), which meets the limitation of notifying unauthorized individuals that they are not authorized to use the resource.

9. Claims 34, 37-44, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanaoka, U.S. Publication No. 2006/0045595, in view of Haruna, JP 2003122209. Referring to claims 34, 39, 40, 60, Hanaoka discloses printer rental system that includes a printer (Figure 1, 100), which meets the limitation of a printing mechanism configured to print images, wherein the dock is configured to receive a stack of sheets of print medium. The printer utilizes cartridges delivered by the rental service (Figure 1), which meets the limitation of a dock configured to removable receive a cartridge containing a consumable resource for use by the device to form a product having a printed image, the dock is configured to receive a cartridge containing a supply of print medium. The printer authenticates use of the cartridge by comparing a user permit ID with a previously stored use permit ID ([0073]), which meets the limitation of a sensor configured to identify authorization data associated with the cartridge, and a controller configured to limit use of the resource by the device based upon identified authorization data associated with the cartridge. Hanaoka does not disclose that the authorized user is permitted to use a predetermined portion of the resources. Haruna discloses an accounting system for use in the printing environment wherein users prepay for a predetermined amount of resources ([0031] & [0037]), which meets the limitation of the controller is configured to permit use of a

predetermined portion of the resource by the device based upon identified authorization data associated with the cartridge, the predetermined portion is less than all of the resource contained in the cartridge. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the users in Hanaoka to prepay for printing resources as discussed in Haruna in order to provide users with the ability to pay only for what they need as suggested by Haruna ([0004] & [0062]).

Referring to claim 37, Hanaoka discloses that the printer can be a laser printer with toner cartridges ([0084]), which meets the limitation of the dock is configured to receive a cartridge containing toner and wherein the print mechanism includes a photoconductive drum.

Referring to claim 38, Hanaoka discloses that the printer can be an inkjet printer with ink cartridges ([0084]), which meets the limitation of the dock is configured to receive a cartridge containing a fluid and wherein the print mechanism includes a fluid dispensing printhead.

Referring to claim 41, Hanaoka discloses that if the use permit ID is invalid, an error message is generated and printing is denied ([0073]), which meets the limitation of the controller is configured to prevent any use of the resource by individuals not included in the authorization data.

Referring to claims 42-43, Hanaoka discloses that the user utilizes a computer containing a display which is capable of displaying notification messages (Figure 1, 10), which meets the limitation of a notification mechanism configured to notify unauthorized individuals that they are not authorized to use the resource, the notification mechanism includes a visual display.

Referring to claim 44, Hanaoka discloses that the user can manually enter the user permit ID in the computer (Figure, 10 & [0080]), which meets the limitation of a user interface configured to receive authorization from a user requesting the use of the consumable resource.

10. Claims 16, 17, 31, 32, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanaoka, U.S. Publication No. 2006/0045595, in view of Asakura, U.S. Patent No. 6,711,362, and further in view of Haruna, JP 2003122209. Referring to claims 16, 17, 31, 32, and 58, Hanaoka does not disclose varying levels of access to the resource. Haruna discloses an accounting system for use in the printing environment wherein users prepay for a predetermined amount of resources ([0031] & [0037]), which meets the limitation of the authorization granting interface is configured to grant varying levels of authorization to use of the resource, the processor is configured to allow limited non-zero use of the first consumable resource in the image forming device. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the users in Hanaoka to prepay for printing resources as discussed in Haruna in order to provide users with the ability to pay only for what they need as suggested by Haruna ([0004] & [0062]).

Allowable Subject Matter

11. The indicated allowability of claims 16, 17, 31, and 32 are withdrawn in view of the newly discovered reference(s) to Haruna, JP 2003122209.

12. Claims 12, 26, 29, 56, and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/
Primary Examiner, Art Unit 2432